

REMARKS

Applicant cancelled claims 351-359 without prejudice or disclaimer of their subject matter, and amended claim 172 to further define Applicant's claimed invention.

The Examiner rejected claims 172-176, 178-181, 183, 184, 190-192, and 202 (including independent claim 172) under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,875,595 to Froning ("Froning") in view of U.S. Patent No. 4,414,962 to Carson ("Carson") and U.S. Patent No. 4,878,915 to Brantigan ("Brantigan"). In response, Applicant submits that Carson is non-analogous art to the claimed invention, and that the combination of Froning, Carson, and Brantigan does not teach or suggest each and every element of the claimed invention recited in independent claim 172, as amended. As such, Applicant submits that amended independent claim 172, is patentable over the Examiner's rejection under 35 U.S.C. § 103(a) based on the combination of Froning, Carson, and Brantigan.

I. Relevant case law regarding 35 U.S.C. § 103(a).

In KSR International Co. v. Teleflex Inc. et al., the Supreme Court reaffirmed the framework for governing obviousness under 35 U.S.C. § 103(a) as set forth in Graham et al. v. John Deere Co. of Kansas City et al., 383 U.S. 1, 148 U.S.P.Q. 459 (1966). (See KSR v. Teleflex, 127 S.Ct. 1727 (2007).) Under Graham v. John Deere, the question of obviousness is resolved on the basis of factual determinations including (1) the scope and content of the prior art, (2) the differences between the claimed invention and the prior art, (3) the level of ordinary skill in the pertinent art, and (4) where in evidence, so-called secondary considerations. (Graham v. John Deere, at 17-18, 148 U.S.P.Q. at 467.) However, even under Graham v. John Deere, prior art that is non-analogous to the claimed invention, or a combination of references that does not teach or suggest each and every element of the claimed invention supports a finding of nonobviousness.

A. Case law regarding non-analogous art.

According to the Federal Circuit, the non-analogous art test "requires...that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as

a basis for rejection." (*In re Kahn*, 441 F.3d 977, 987 (Fed. Cir. 2006) (citing *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992)).) Furthermore, according to MPEP § 2141.01, "a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole." Hence, the pertinence of a reference is determined by if the reference can be logically associated with the claimed invention.

B. Case law regarding a combination of references that does not teach all limitations of the claimed invention.

According to the Federal Circuit, "a searching comparison of the claimed invention – *including all its limitations* – with the teachings of the prior art" is required of the Examiner when determining whether a claim is obvious. (*In re Ochial*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added).) As such, "obviousness requires a suggestion of all limitations in a claim." (*CFMT, Inc. v. YieldUP Int'l. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974)).) Accordingly, a combination of references that does not result in each and every limitation of the claimed invention can be determinative of a finding of nonobviousness and to defeat a rejection under 35 U.S.C. § 103(a).

II. Discussion regarding Carson.

Carson is directed to an operating arthroscope, and one embodiment thereof is depicted in Fig. 1. The arthroscopes discussed in Carson are used to examine damage to a joint through a small incision. For example, the arthroscope depicted in Fig. 1 is a generally rectangular conduit including an objective lens (11), an irrigation conduit (12), and an instrument channel (14). The objective lens (11) allows a surgeon to see the damage to the interior of the joint, and the irrigation conduit (12) and the instrument channel (14) allows the surgeon to manipulate the area around the portion of the joint being viewed. According to Carson, "[t]ypical operating arthroscopes of this invention are between 3 to about 5 millimeters thick, desirably less than about 4.5 millimeters thick." (Carson at column 5, lines 61-63.)

In rejecting independent claim 172, the Examiner cites to an arthroscope depicted in Fig. 3 of Carson. Carson indicates that arthroscopes (61, 62, 63, and 64) depicted in Fig. 3 are "conventional instruments in current use." (Carson at column 6, lines 23 and 24.) Specifically, the Examiner relies on arthroscope (61) of Fig. 3 in promulgating the rejection under 35 U.S.C. § 103(a). The arthroscope (61) includes an objective lens (71), an instrument channel (72), and a pair of irrigation channels (73). Regarding the arthroscope (61), the Examiner indicates that Carson teaches "it is known to create an instrument for surgery on bone having multiple circular channels (72 and 73, see figure 3) to allow multiple instruments to be used in the surgical site at the same time." (Office Action at page 3, lines 18-20.) According to Carson, the instrument channel (72) is 3 mm in size, and the irrigation channels (73) (when properly labeled¹) are smaller than the instrument channel (72).

III. Carson is non-analogous art to the claimed invention, and, even if Carson was analogous art, the Examiner has relied on hindsight in combining Froning and Carson.

Applicant submits that the arthroscope (61) is non-analogous art to the claimed invention recited in amended independent claim 172. Applicant acknowledges that the instrument channel (72) is provided to insert instruments therethrough, and the irrigation channels (73) are provided to transfer irrigation fluid. However, Applicant submits that the limited sizes of the instrument channel (72) and the irrigation channels (73) would not afford insertion of a spinal implant therethrough. As discussed above, the instrument channel (72) is 3 mm in size, and the irrigation channels (73) (when properly labeled) are smaller than the instrument channel (72). However, as discussed in the present application, the size of the representative spinal implant discussed therein is 18 mm (see page 26, line 13) in diameter. Therefore, Applicant submits that one of

¹ Applicant notes that Fig. 3 of Carson appears to be mislabeled. As the specification of Carson refers to "a pair of irrigation channels 73," Applicant submits that (to comport with the specification) elements of the arthroscope (61) labeled (72) should be labeled (73), and the element labeled (72) should be labeled (72).

ordinary skill in the art would not look to the instrument channel (72) or the irrigation channels (73) for teachings regarding insertion of a spinal implant therethrough. The significant size differences do not make the instrument channel (72) or the irrigation channels (73) logically relevant to the necessary size of a passage for passing even a portion of a spinal implant. As such, Applicant submits that Carson is non-analogous to the claimed invention recited in amended independent claim 172, and hence, the rejection under 35 U.S.C. § 103(a) based on the combination of Froning, Carson, and Brantigan cannot be maintained.

Applicant also submits the Examiner is relying on hindsight in constructing the combination of Froning, Carson, and Brantigan. The Supreme Court in KSR v. Teleflex did not abandon its guidance regarding hindsight reasoning. According to the Supreme Court, "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." (KSR, at 1742.) In cautioning of the distortion caused by hindsight reasoning, the Supreme Court cited to Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co., 332 F.2d 406 (6th Cir. 1964). In Monroe Auto, the Sixth Circuit indicated "[m]any things may seem obvious after they have been made, and for this reason courts should guard against slipping into use of hindsight." (Monroe Auto, at 412.) Furthermore, in Monroe Auto, the Sixth Circuit cited Application of Sporck, 301 F.2d 686, for the proposition that the factfinder "must be careful to 'view the prior art without reading into that art the teachings of [Patent Owner's] invention.'" (Monroe Auto, at 412.)

Given significant size differences between the instrument channel (72) or the irrigation channels (73) and the necessary size of a passage for passing even a portion of a spinal implant, Applicant submits that the Examiner has relied on hindsight in constructing the combination of Froning, Carson, and Brantigan. Thus, Applicant again submits that the rejection of amended independent claim 172 under 35 U.S.C. § 103(a) based on the combination of Froning, Carson, and Brantigan cannot be maintained.

IV. The combination of Froning, Carson, and Brantigan does not result in each and every limitation of the claimed invention recited in amended independent claim 172.

Amended independent claim 172 recites first and second passages "being adapted to receive at least a portion of a spinal implant therethrough." Froning discloses a tube 31 having a single passage therethrough. The Examiner relies on Carson for disclosing a guard having two passages. (See Office Action at page 3, lines 17-23.) However, as discussed above, the instrument channel (72) is 3 mm in size, and the irrigation channels (73) (when properly labeled) are smaller than the instrument channel (72), and the size of the representative spinal implant discussed in the present application is 18 mm in diameter. As such, Applicant submits that neither Froning nor Carson disclose first and second passages "being adapted to receive at least a portion of a spinal implant therethrough." Accordingly, Applicant submits that the combination of Froning, Carson, and Brantigan does not result in each and every limitation of amended independent claim 172, and therefore, amended independent claim 172 is patentable over the Examiner's rejection under 35 U.S.C. § 103(a).

V. Conclusion.

In conclusion, Applicant submits that independent claim 172 is patentable and that dependent claims 173-176, 178-181, 183-192, 197-200, and 202-206, dependent from independent claim 172, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim. Therefore, in view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Accordingly, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

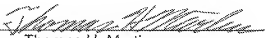
To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including

any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

MARTIN & FERRARO, LLP

Dated: April 29, 2011

By: 
Thomas H. Martin
Registration No. 34,383

1557 Lake O'Pines Street, NE
Hartville, Ohio 44632
Telephone: (330) 877-0700
Facsimile: (330) 877-2030